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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/993,946 12/18/97 SILVESTRINI

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QM12/1004

EXAMINER

WILLSE, D

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

10/04/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/993,946

Applicant(s)
SILVESTRINI

Examiner
Dave Willse

Group Art Unit
3738



☒ Responsive to communication(s) filed on Dec 18, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-25 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 3738

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17 and 20-24, drawn to methods of implanting an intracorneal implant, classified in class 606, subclass 107.
- II. Claims 18-19, drawn to dissectors for forming an intracorneal cavity, classified in class 606, subclass 166.
- III. Claim 25, drawn to an intracorneal insert, classified in class 623, subclass 5.

(Note: It is assumed that claims 22 and 23 are intended to depend from a method claim rather than from dissector claim 18.)

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the dissector as set forth in claim 18 can be used to form a set of arc shaped channels for arc shaped implants rather than a circular channel with a continuous ring implant; instead of the kit of claim 19, the methods as claimed can be performed with a single dissector which is expandable by inflation, temperature effects, mechanical means, etc. to widen the channel.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

Art Unit: 3738

§ 806.05(h)). In the instant case, the product as claimed can be used in a materially different process such as the creation of a large circular incision to receive the insert or the injection of curable material to form the continuous ring shape.


Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. The inventions have separate utility, as explained above. (Reference is made to MPEP § 806.05(d).)

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications and divergent required searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is (703) 308-2903. The supervisory patent examiner is Mickey Yu, whose telephone number is (703) 308-2672. The receptionist's phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse
September 30, 1999


DAVE WILLSE
PRIMARY EXAMINER
ART UNIT 3738